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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,855	07/19/2005	Ole-Jacob Siljan	2005_0237A	3561
513 7590 07/20/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
MENDEZ, ZULMARIAM				
ART UNIT		PAPER NUMBER		
1795				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,855

Applicant(s)

SILJAN ET AL.

Examiner

ZULMARIAM MENDEZ

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-77 is/are pending in the application.
4a) Of the above claim(s) 65-77 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 39-64 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/ISD)
Paper No(s)/Mail Date 02/18/2009
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, embodied by claims 39-64, in the reply filed on April 28, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 62, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For examination purposes, the examiner has considered heat pipes and/or flow channels connected to the anode.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 39-42, 44-47, 49, 55, 58 rejected under 35 U.S.C. 102(b) as being anticipated by Jarrett et al. (US Patent no. 4,737,247).

With regard to claims 39-42, 44-47, 55, Jarrett discloses a method for electrolytic production of aluminum metal from an electrolyte comprising alumina (aluminum oxide), by performing electrolysis in an electrolysis cell (col. 2, lines 28-33) containing at least one electrolysis chamber with at least one bipolar electrode containing both anode and cathode (col. 1, lines 47-52 and 58-65), where the anode evolves oxygen gas and the cathode has aluminum discharged onto it in the electrolysis process (col. 2, lines 39-63), said oxygen gas enforcing an electrolyte flow pattern upward (col. 3, lines 27-29; see figure) and said produced aluminum flowing downward due to gravity (col. 2, lines 58-63), wherein the temperature of the electrodes are controlled and maintained at a level different from that of the surrounding electrolyte by means of active or passive cooling and/or active and passive heating, such as by having heat pipes, with at least one flow channel connected to the anode stem (col. 2, line 63 to col. 3, line 31, see figure), the cooling medium in the heat pipes may be gas or liquid sodium or potassium (col. 3, lines 3-18) and wherein the anode is attached to the electrical conductor system through an electric connection (see claim 3).

With regard to claim 49, Jarrett further teaches wherein the anode has an anode stem (top portion of the anode which is parallel to the heating pipe (9)) between the submerged anode (2) and the electrical connection (the figure shows wherein the anode

is electrically connected to the positive terminal of a power supply), said stem having a cross sectional ratio to the anode cross section area of at least 0.005 - 0.5. As shown in the figure, the cross sectional area of the anode stem is smaller than half the cross sectional area of the anode (2).

With regard to claim 58, Jarrett discloses wherein the cathode (3) has a cathode stem (bottom portion of the cathode) between the submerged anode (3) and the electrical connection (the figure shows wherein the cathode is electrically connected to the negative terminal of a power supply), said stem having a cross sectional ratio to the cathode cross section area of at least 0.005 - 0.5. As shown in the figure, the cross sectional area of the cathode stem is smaller than half the cross sectional area of the cathode (3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 48, 50-54, 57, 59-60, 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarrett, as applied to claim 46 above.

With regard to claims 48 and 57, Jarrett teaches all of the method steps, as discussed above, wherein said cooling of electrical connection is obtained by using an highly electrical conductive metal but fails to teach wherein it has a large cross sectional area of at least 1.1 - 5.0 times the cross sectional area of the anode stem cross sectional area. It has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). Also see MPEP 2144.

With regard to claims 50-51, 53, 54, 59 and 64, Jarrett discloses all of the method steps, as discussed above, wherein the cathode stem has a cross sectional ratio to the cathode cross section area of at least 0.005 - 0.5. As shown in the figure, the cross sectional area of the cathode stem is smaller than half the cross sectional area of the cathode (3); and wherein the cross sectional area of the submerged cathode compared to the submerged anode area is about the same as shown in the figure; but fails to explicitly teach wherein the cathode is maintained at a temperature at least at

the same level as the electrolyte, preferably slightly higher. However, Jarrett does disclose modifying the temperature of the system and keeping the electrolyte at a temperature different from the electrolytic bath temperature in order to protect the electrode from attack by the corrosive electrolyte as well as to enhance the production of aluminum (col. 2, lines 1-55). Therefore, one having ordinary skill in the art at the time of the invention would have found it obvious to modify the temperature of the electrolytic cell in such a way that both the electrodes and the electrolyte are kept at a different temperature, as taught by Jarrett, in order to protect the electrode from attack by the corrosive electrolyte as well as to enhance the production of aluminum.

With regard to claim 52, even though Jarrett fails to explicitly teach wherein said intermediate electric current lead is manufactured from dense oxidation resistant graphite, a metal and/or a metal alloy such as stainless steel, Incoloy and/or Hastaloy, one having ordinary skill in the art at the time of the invention would have found it obvious to use a metal or a metal alloy such as stainless steel as the electric current lead because stainless steel is well known in the art to be an excellent electrical conductor as well as to have good corrosion resistance properties. Both the electrolytic bath and coolants used in the method taught by Jarrett are corrosive.

With regard to claim 60 and 62, Jarrett teaches wherein the temperature of the electrodes are controlled and maintained at a level different from that of the surrounding electrolyte by means of active or passive cooling and/or active and passive heating, such as by having heat pipes, with at least one flow channel connected to the anode stem (col. 2, line 63 to col. 3, line 31, see figure).

With regard to claim 63, Jarrett discloses wherein the cathode of the bipolar electrode is heated by means of inserting a layer of a material with higher electrical resistivity/spacer or positioning member (4), than the cathode material between the cathode (3) and the adjacent anode (2; abstract; col. 1, lines 58-65; col. 2, lines 3-11).

10. Claims 43, 56 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarrett, as applied to claim 42 above, in view of Brown (US Patent no. 4,678, 548).

With regard to claims 43, 56 and 61, Jarrett discloses all of the method steps, as discussed above, wherein the electrodes are attached to an electrical conductor system through an electrical connection (see figure and claim 3), said connection being cooled by means of liquid or gas cooling, such as sodium or potassium (col. 2, line 63 to col. 3, line 31); but fails to teach wherein said liquid coolants are water, heavy alcohols, oils, synthetic oils, mercury and/or molten salts.

Brown teaches a method and apparatus for supporting and positioning inert electrodes in electrolytic reduction cells for the production of aluminum (col. 1, lines 9-12) wherein a heat transfer fluid, such as water is passed through a cavity of an inside surface of a positioning means (col. 2, lines 6-17; col. 3, lines 34-36) in order to provide a high heat transfer. Therefore, one having ordinary skill in the art would have found it obvious to use water as a coolant medium, as taught by Brown, in the method of Jarrett, in order to provide a high heat transfer.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZULMARIAM MENDEZ whose telephone number is (571)272-9805. The examiner can normally be reached on Monday-Friday from 9am to 5pm.
12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Michener can be reached on 571-272-1424. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, Art Unit 1795

/Z. M./
Examiner, Art Unit 1795